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**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

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*[Handwritten mark]*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/332,522

06/14/99

COSTA

M

7326-101

020583

HM22/0505

PENNIE AND EDMONDS

1155 AVENUE OF THE AMERICAS

NEW YORK NY 10036-2711

EXAMINER

SHUKLA, R

ART UNIT

PAPER NUMBER

1632

DATE MAILED:

05/05/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/332,522

Applicant(s)

COSTA ET AL.

Examiner

Ram R Shukla

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-33 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

### Attachment(s)

- 14) ☐ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 17) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

1. Claims 1-33 are pending in the instant application.
2. **Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures.**

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures.

***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, 6-18, 22-28, drawn to a transgenic nematode comprising SREBP encoding nucleic acid and uses thereof, classified in class 800, subclass 8.
  - II. Claims 1-9, 12-14, 18, and 22-28, drawn to a transgenic fly comprising SREBP encoding nucleic acid and uses thereof, classified in class 800, subclass 8.
  - III. Claims 1-4, 6-18, 22-28, drawn to a transgenic nematode comprising SCAP encoding nucleic acid and uses thereof, classified in class 800, subclass 8.
  - IV. Claims 1-9, 12-14, 18, and 22-28, drawn to a transgenic fly comprising SCAP encoding nucleic acid and uses thereof, classified in class 800, subclass 8.
  - V. Claims 19-21, drawn to a method of determining the lipid content of a nematode, classified in class 800, subclass 3.
  - VI. Claims 29, 30, and 33, drawn to SREBP pathway proteins and method of detecting molecules that bind to said proteins, classified in class 530, subclass 350.1.
  - VII. Claims 31-32, drawn to a nucleic acid construct wherein a SREBP promoter drives the expression of a nucleic acid sequence, classified in class 435, subclass 320.1.

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4. Claims 1-9, 12-14, 18, and 22-28 encompass subject matter of the inventions of the groups I and III. Should any of these groups be elected, claims 1-9, 12-14, 18, and 22-28 will be examined to the extent they encompasses the elected subject matter.

5. Claims 1-4, 6-18, and 22-28 encompass subject matter of the inventions of the groups II and IV. Should any of these groups be elected, claims 1-4, 6-18, and 22-28 will be examined to the extent they encompasses the elected subject matter.

6. Claims 1-4, 6-9, 12-14, 18, and 22-28 encompass subject matter of the inventions of the groups I-IV. Should any of these groups be elected, claims 1-4, 6-9, 12-14, 18, and 22-28 will be examined to the extent they encompasses the elected subject matter.

7. The inventions are distinct, each from the other because of the following reasons:

The inventions of the groups I-II and III-IV are distinct because they are drawn to different transgenic animals of different species expressing different nucleic acids. For example, the inventions of the groups I and III are both drawn to transgenic flies, however, they express different nucleic acids, SREBP and SCAP encoding polynucleotides. Since these two sequences encode two different proteins, the transgenic nematodes expressing these proteins may have different characteristics, and furthermore they are produced by expressing transgenes that have different sequence structures. The inventions of the groups II and IV are drawn to transgenic nematodes which express different proteins and the transgenes expressing these proteins will have different sequence structure. Furthermore, these nematodes may have different characteristics. Additionally, the transgenic flies and nematodes expressing same transgene may also have different phenotypes. The inventions of the groups I and III are distinct from the inventions of each of the groups II and IV because they are drawn to different transgenic animals, flies and nematodes that express different transgenes that encode different proteins. Therefore, the inventions of the groups I-IV will require separate searches, for example, in the non-patent literature.

The invention of the group V is drawn to a method of determining the lipid content of a living nematode using a fatty acid conjugate and is patentably distinct from the inventions of

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each of the groups I-IV because the method of group can be practiced without the use of the transgenic animals of the groups I-IV. Furthermore, the transgenic animals of the gorups I-IV can not be produced by the method of the groups V. Additionally, the phenotype and characteristics of the transgenic nematodes of the groups I-IV will also be different from those of the nematodes used in the method of group V because the nematodes of group V may comprise any transgene or may not comprise any transgene at all.

The invention of group VI, drawn to proteins of SREBP pathway, are patentably distinct from the inventions of the groups I-V because they are drawn to materially different compositions and also because the proteins of the group VI can not be used for making the transgenic animals of the groups I-IV or for practicing the method of group V. Furthermore, the utilities of the inventions of the group VI will be different from those of the inventions of the groups I-V, such as for producing antibodies or in enzyme assays or for therapy. The invention of the group VII is drawn to a nucleic acid construct for expression of a nucleic acid using the promoter of SREBP promoter and is patentably distinct from the inventions of the groups I-VI because the inventions of the groups I-VI can not be practiced using the nucleic acid construct of group VII and also because the invention of group VII may express any encoding sequence that may be any protein, such as reporter gene or a selectable marker. Furthermore, the utilities of the inventions of the groups I-VII may be different each from the other. In conclusion, the inventions of the groups I-VII are patentably distinct each from the other and their analysis will require separate searches, for example, in the non-patent literature.

8. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art shown by their different classification and their recognized divergent subject matter, and because each invention requires a separate, non-coextensive search, restriction for examination purposes as indicated is proper.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on Monday through Thursday and every other Friday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasmine Chambers, can be reached on (703) 308-2035. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-0196.

Ram R. Shukla, Ph.D.

*Karen M. Hauda*  
Karen M. Hauda  
Patent Examiner